

d.) Remarks.

Priority.

The Patent Office stated that the Applicant had not complied with the requirements of 37 CFR 1.63(c) when they claimed priority from a foreign (German) application (page 2, item 1) filed in Germany on March 13, 2001. Applicant respectfully points out the following quotation from rule 37 C.F.R. 1.63(c) (emphasis added):

(c) Unless such information is supplied on an application data sheet in accordance with §1.76, the oath or declaration must also identify:

(1) [...]

(2) Any foreign application for patent (or inventor's certificate) for which a claim for priority is made pursuant to § 1.55, [...].

Rule 1.63 (c) says that a priority claim to a foreign application is properly made either on the application data sheet or in the declaration. Applicant filed the application data sheet with a proper priority claim to German application DE 101 11 824.4 and its filing date of March 13, 2001, to the Patent Office on February 20, 2002, the filing date of the present application. A copy of the application data sheet containing the proper priority claim as filed with the application is enclosed with this response. Therefore, no new declaration is necessary for this case and the requirement to furnish a new declaration has to be withdrawn.

Specification.

The function of the aim marks is disclosed in the paragraph [0005] of the application, as published.

Claim Rejections 35 U.S.C. 112.

Claims 6-7 and 17-21 have been rejected under 35 U.S.C. 112, second paragraph.

Applicant believes that Claims 6, 15, 17, and 21, as amended, bring the Claims 6-7 and 17-21 into compliance with 35 U.S.C. 112. The rejections under 35 U.S.C. 112 should be withdrawn.

Objections.

Claims 2, 3, and 7 were amended to correct the informalities. Claim 4 was amended to correct the same informality.

Claim Rejections 35 U.S.C. 102 and 35 U.S.C. 103.

Claims 13, 22-26 and 27 were rejected under 35 U.S.C. 102(b) over U.S. Patent 5,532,873 to Dixon ("Dixon"). Applicant disagrees and asserts as follows.

Amended Claim 13 has an element, which is an adjustable optical element in the beam path of the microscope. Dixon does not disclose an adjustable optical element. To the contrary, Dixon discloses a turret or a slider which carries at least two objectives with different magnification. Dixon shows that an objective (400) can be positioned in the illumination/detection beam path. Positioning in Dixon is not adjusting, as claimed in amended Claim 13.

Also, the element "at least one device for adjusting" was amended to more precisely point out the invention. Device 70 (also described in paragraph 21 of the specification as published) is positioned in the beam path of a microscope and can be used to detect alignment or misalignment of the beam path and adjust the optical element according to the detected alignment. No such disclosure could be found in Dixon. Therefore, the rejection should be withdrawn and Claim 13 as amended should be allowed.

Claims 22-26 and 27 depend off amended Claim 13 and should be allowed.

Claims 13, 22-26 and 27 were rejected under 35 U.S.C. 102(e) over U.S. Patent 6,570,705 to Bewersdorf ("Bewersdorf"). Applicant disagrees and asserts as follows.

Bewersdorf's effective filing date in the U.S. September 18, 2001, which is later than Applicant's priority date of March 13, 2001. Since under 35 U.S.C. 102(e) the effect of Bewersdorf as a reference against the Applicant goes back only to Bewersdorf's effective filing date in the U.S., Bewersdorf cannot be used as a basis for the issued

102(e) rejection, which should be withdrawn. Claims 13, 22-26 and 27 should be allowed.

Claims 1, 6-14, 16-17, and 21-22 were rejected under 35 U.S.C. 102(e) under U.S. Patent 6,693,272 to Adachi ("Adachi"). Also, Claims 23-27 were rejected under 35 U.S.C. 103(a) over Adachi in view of Dixon. Claims 2-5, 15 and 18-20 were rejected under 35 U.S.C. 103(a) over Adachi in view of U.S. Patent 5,657,128 to Muller ("Muller"). The above enumerated rejections should be withdrawn.

Adachi's date against the Applicant under 102(e) is its effective filing date in the U.S., which is March 7, 2001. Applicant respectfully submits a Declaration under 37 C.F.R. 1.131 (enclosed with this response), establishing the date of conception and reduction to practice of the claimed invention no later than December 21, 2000, which is earlier than the March 7, 2001 Adachi effective U.S. filing date. Therefore, Adachi cannot be cited against Applicant's claims in the above referenced rejections. The 102(e) and 103(a) rejection thus should be withdrawn, Claims 1, 6-14, 16-17, and 21-22, 23-27, 2-5, 15 and 18-20 should be allowed.

Claims 13-14 and 22 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,084,612 to Iwasaki et al. ("Iwasaki").

Iwasaki, in columns 14-15 and Fig. 10, describes a confocal scanning microscope. The laser beam, 11 and 11', goes through a sequence of optical elements 12, 13, 14, 16, 6, 17, 19, 20 and is guided via an optical fiber 24, lens 25, and three mirrors 26, 28, and 30 to three photodetectors 27, 29, and 31 to generate three color components of an image of a sample 23 positioned on a supporting member 22. The optical elements, 12, 13, 14, 16, 6, 17, 19, 20, 24, and 25, form the optical axis of the microscope shown in Fig. 10. The position of the laser beam, 11 and 11', with respect to this optical axis remains unchanged. The position of the laser beam, 11 and 11' with respect to the sample 23 and the supporting member 22, does change. However, this change does not alter the position of the laser beam, 11 and 11' with respect to the optical axis in Iwasaki, as defined, for example, at column 15, lines 26-30.

Independent Claim 13, as amended, includes as an element at least one device for adjusting by determining a position of a light beam with respect to the optical axis of the

microscope. In Iwasaki, the position of the laser beam 11 and 11' does not change and Iwasaki does not describe determining the position of the laser beam 11 and 11'.

It is well established that a claim is anticipated under 35 U.S.C. §102, only if each and every element of the claim is found in a single prior art reference.¹ Moreover, to anticipate a claim under 35 U.S.C. §102, a single source must contain each and every element of the claim "arranged as in the claim."^{2,3} Missing elements may not be supplied by the knowledge of one skilled in the art or the disclosure of another reference.⁴ If each and every element of a claim is not found in a single reference, there can be no anticipation.

As it had been shown above, limitations of independent amended Claim 13 are not described, expressly or inherently, in Iwasaki. Therefore, the Applicant respectfully asserts that amended Claim 13 is not anticipated by Iwasaki. Withdrawal of the 102(b) rejection over Iwasaki and allowance of amended Claim 13 are respectfully requested.

Claims 14 and 22 depend off now allowable Claim 13 and are therefore allowable. Allowance of Claims 14 and 22 is respectfully requested.

Applicant believes that the present application is in condition for allowance. A Notice of Allowance is respectfully solicited. Should any questions arise, the Examiner is encouraged to contact the undersigned.

Respectfully Submitted,

Houston Eliseeva LLP

By

Ilya R. Lapshin, Reg. No. 54,251

4 Militia Drive, Ste. 4
Lexington, MA 02421
Tel: 781-863-9991
Fax: 781-863-9931

Date: June 29, 2004

¹ *Veregal Bros. v Union Oil Co. of California*, 814 F.2d 628, 631, 2USPQ2d 1051, 1053 (Fed. Cir. 1987).

² *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984).

³ *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q. 2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988).

⁴ *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780, 227 U.S.P.Q. 773, 777 (Fed. Cir. 1985).